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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,631	09/18/2003	Robert Birch	1160215/0514436	9238

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FROST BROWN TODD LLC  
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EXAMINER
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GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3691

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03/10/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/666,631	BIRCH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Clement B. Graham	3696	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/14/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/13/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

**1. 35 U.S.C. 101 reads as follows:**

**Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

Claims 1, 16-17 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Corriganal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, Applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals

Informative Opinion Ex parte Langemyer et al.

### ***Claim Rejections - 35 USC § 103***

**2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Vadlamani U.S. Pub: 20020161676 in view of Corrigan et al (Hereinafter Corrigan U.S Patent: 6640, 097).

As per claim 1, Vadlamini discloses a computerized method for billing for web services comprising the steps of:

creating a descriptor file designating a pre-defined element (“i. e, a file within a web server database that monitor “time usage” see column 3 para 0040”) and (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004) configuring a handler (“i. e, database”) to monitor a web service network communication, between a service requestor (“i. e , customer or client”) and a service provider, for said predefined element in said descriptor file (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31) configuring said handler to send said pre-defined element to a set of programmed instructions to create an event record (“i. e, time usage record stored in database” see column 3 para 0043”) wherein the handler configured to monitor for said predefined element in said descriptor file is located at an entity taken from the list of entities consisting of, (a) the service requestor; and (b) the service provider (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

Vadlamini fails to explicitly teach electronically transmitting said event record to a billing system for further processing.

However Corrigan discloses electronically transmitting said event record to a billing system for further processing (see column 2 lines 40-42 and column 7 lines 44-65 and claim 9). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Vadlamini to include electronically transmitting said event record to a billing system for further processing taught by Corrigan in order to transmit billing event information for processing.

As per claim 2, Vadlamini discloses wherein said programmed instructions are configured to determine whether an event corresponding to said event record requires authorization (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 3, Vadlamini discloses a computerized method as claimed in claim 1 wherein said programmed instructions are configured to determine whether an event corresponding

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to said event record requires rating (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 4, Vadlamini discloses further comprising the steps of transforming said pre-defined element according to a set of instructions in said descriptor file before transmitting said event record to the billing system (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 5, Vadlamini discloses wherein said web service network communication comprises a request for a web service and a response to said request wherein said request comprises a start time and said response comprises an end time and further comprising the steps of:

creating a first event record comprising said start time (“i. e, a file within a web server database that monitor “time usage” see column 3 para 0040”) and (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004) queuing said first event record in said billing system, creating a second event record comprising said end time (“i. e, time usage record stored in database” see column 3 para 0043”) matching said first event record with said second event record, calculating a charge for said web service based on said start time and said end time, returning said charge to said service provider (see column 1 para 0003-0004).

Vadlamini fails to explicitly teach sending said first event record to said billing system, and sending said second event record to said billing system, queuing said first event record in said billing system.

However Corrigan discloses electronically transmitting said event record to a billing system for further processing (see column 2 lines 40-42 and column 7 lines 44-65 and claim 9).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Vadlamini to include sending said first event record to said billing system, and sending said second event record to said billing system, queuing said first event record in said billing system taught by Corrigan in order to transmit billing event information for processing.

As per claim 6, Vadlamini discloses wherein said billing system comprises programmed billing instructions coded to determine whether a web service transaction may be performed (see

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column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 7, Vadlamini discloses wherein said programmed billing instructions are configured to determine if said service requestor is permitted to access said web service transaction (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 8, Vadlamini discloses wherein said billing system returns a response to said web service provider indicating whether said web service transaction should proceed (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 9, Vadlamini discloses wherein said programmed billing instructions are configured to determine whether said service requestor is solvent enough to purchase said web service transaction (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 10, Vadlamini discloses wherein said programmed billing instructions are configured to return a response to a set of application code associated with said web service provider indicating whether said web service transaction should proceed (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 11, Vadlamini discloses wherein said programmed billing instructions are configured to return a response to said web service provider indicating a quantity for said web service transaction to proceed (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 12, Vadlamini discloses wherein said web service network communication comprises a SOAP message stream; wherein the service requestor accesses the service provider on a direct peer-to-peer basis; and wherein the handler is located at the service provider (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 13, Vadlamini discloses wherein said SOAP message stream comprises a set of data including quality of service information, authorization key fields, version numbers,

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encrypted account information, and start/stop time (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 14, Vadlamini discloses wherein said billing system uses said pre-defined element in said SOAP message stream to support at least one pre-defined billing plan (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 15, Vadlamini discloses wherein said pre-defined billing plans is chosen from a list consisting of subscriptions, bundled plans, time-based usage plans, re-occurring charges, one-time charges, discount plans based on usage, discount plans based on time-of-day, discount plans based on customer loyalty, discount plans based on family/organization relationships, tiered plans, location dependent pricing, and combinations thereof (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 16, Vadlamini discloses a computer-readable medium having computer executable instructions for performing a method comprising:

receiving a descriptor file designating at least one pre-defined element("i. e, file within a web server database that monitor "time usage" see column 3 para 0040") and (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004)

utilizing said descriptor file to monitor a web service network communication for said pre-defined element(s) (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31) copying said-predefined element(s) from said network communication into a record ("i. e, time usage record stored in database" see column 3 para 0043").

Vadlamini fails to explicitly teach electronically sending said record to a billing system for further processing.

However Corrigan discloses electronically transmitting said event record to a billing system for further processing (see column 2 lines 40-42 and column 7 lines 44-65 and claim 9).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Vadlamini to include electronically sending said record to a billing system for further processing taught by Corrigan in order to transmit billing event information for processing.

As per claim 17, Vadlamini discloses a system for billing for web services comprising: a descriptor file, a handler (“i. e, a file within a web server database that monitor “time usage” see column 3 para 0040”) a record (“i. e, time usage record stored in database” see column 3 para 0043”) wherein said descriptor file designates at least one pre-defined elements (“i. e, a file within a web server database that monitor “time usage” see column 3 para 0040”) said handler is configured to monitor a web service network communication, between a service requestor (“i. e , customer or client”) and a service provider, and to intercept said communication if said communication corresponds to said at least one pre- defined element in said descriptor file (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31) said handler is further configured to copy said pre-defined elements from said network communication into a record (“i. e, time usage record stored in database” see column 3 para 0043”)

Vadlamini fails to explicitly teach a billing system and said handler is further configured to electronically transmit said record to a billing system for further processing.

However Corrigan discloses electronically transmitting said event record to a billing system for further processing (see column 2 lines 40-42 and column 7 lines 44-65 and claim 9). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Vadlamini to include a billing system and said handler is further configured to electronically transmit said record to a billing system for further processing taught by Corrigan in order to transmit billing event information for processing.

As per claim 18, Vadlamini discloses wherein said billing system is embedded within a web service server; wherein said further processing comprises determining whether said service requestor is solvent enough to purchase a web service corresponding to said web service network communication; and wherein said web service network communication comprises a SOAP message stream; wherein said handler is located at the service provider; and wherein the service requestor accesses the service provider on a direct peer-to-peer basis (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 19, Vadlamini discloses wherein the monitored web service network communication is between a service requestor and a service provider, and wherein the computer



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readable medium is located at the service provider (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

As per claim 20, Vadlamini discloses wherein the web service network communication comprises a communication where the service requestor accesses the service provider on a direct peer-to-peer basis (see column 4 para 0051-0052 and column 3 para 0040 and column 1 para 0003-0004 and para 0012 and column 5 claim 31).

### **Conclusion**

### **RESPONSE TO ARGUMENTS**

3. Applicant's arguments filed 7/14/09 has been fully considered but they are moot in view of new grounds of rejection.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/  
Supervisory Patent Examiner, Art  
Unit 3691

CG

Feb 20, 2010